

REMARKS**Pending Claims**

Claims 1-59 were submitted at the time of filing the instant application in the interest of providing notice to the public of certain specific subject matter intended to be claimed. As indicated on page 1 of the "Transmittal for Divisional Application" Applicants requested that original claims 3-10, 12-29, 46-55 and 58-59 be canceled before calculation of the filing fee. Applicants' request was granted as noted on the Filing Receipt, as Applicants have paid for 21 total claims. Thus, claims 1, 2, 11, 30-45, 56 and 57 are currently pending in the instant application. Applicants respectfully request that the Disposition of Claims be corrected in the next Office Action to reflect that only claims 1, 2, 11, 30-45, 56 and 57 are currently pending in the instant application.

Amendments to the Claims

Claims 11, 36, 39, 44 and 45 were amended to either remove dependency from non-elected claim 1 (claim 11), or to specifically recite SEQ ID NO:1 (claims 36, 39, 44 and 45). Applicants believe that the requested amendments place the claims in better form for examination and have not been made for reasons relating to patentability. Applicants respectfully request entry of these amendments.

Restriction Requirement

Applicants hereby elect, with traverse, to prosecute Group 7, which includes and is drawn to Claims 11 and 30-45. Applicants reserve the right to prosecute the subject matter of non-elected claims in subsequent divisional applications.

Rejoinder

The method of use claims, claims 30, 33, 35, 44 and 45, and method of making claims, claims 36 and 39 are entitled to rejoinder upon allowance of a product claim per the Commissioner's Notice in the Official Gazette of March 26, 1996, entitled "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)" which sets forth the rules, upon allowance of a product claim, for rejoinder of process claims covering the same scope of

products. See also M.P.E.P. 821.04 as follows:

Where product and process claims drawn to independent and distinct inventions are presented in the same application, applicant may be called upon under 35 U.S.C. 121 to elect claims to either the product or process. . . . The claims to the nonelected invention will be withdrawn from further consideration under 37 C.F.R. 1.142. . . . However, if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.

Additionally, Applicants traverse the Restriction Requirement as between Group 1 and Group 7 (drawn to the polypeptides of SEQ ID NO:1 and antibodies to the SEQ ID NO:1 polypeptide, respectively). The claims of these groups could be examined at the same time, also without an undue burden on the Examiner. A search of the prior art to determine the novelty of the antibodies would substantially overlap with a search of the claims directed to the polypeptides. Thus, Applicants submit that examining the prior art for the polypeptides together with the antibodies would involve substantially the same subject matter and would not impose an undue burden on the Examiner.

CONCLUSION

If the Examiner contemplates other action, or if a telephone conference would expedite allowance of the claims, Applicants invite the Examiner to contact the undersigned at the number listed below.

Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. **09-0108**.

Respectfully submitted,

INCYTE CORPORATION

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